

## REMARKS

This communication is in response to the final Office Action issued March 5, 2003. The Examiner rejected claims 1-13, 15, 16, and 41-44 under 35 U.S.C. § 102 in view of U.S. Patent No. 3,963,080 to Walker (Walker). The Examiner rejected claim 14 under 35 U.S.C. § 103 in view of Walker modified by U.S. Patent No. 4,192,551 to Weimer *et al.* (Weimer).

### Claim Rejections Under 35 U.S.C. § 102

On pages 2-4 of the Office Action, the Examiner rejected claims 1-13, 15, 16, and 41-44 under 35 U.S.C. § 102 in view of Walker.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy this burden.

Walker appears to teach a method of advancing and steering a mining machine in which the steering is accomplished by side steering shoes 51 and 58 mounted on opposite side of the cutterhead support assembly 14. The steering shoes 51 and 58 are operated by side steering piston and cylinder assemblies 52 and 55. If a wall of the tunnel is absent, piston rods 74, 32 and cylinders 75, 31, mounted on opposite sides of the main beam assembly 6, provide control of the horizontal attitude, *i.e.*, steering of the cutterhead support assembly 14, which is supported at the forward end of the main beam assembly 6 by a multidirectional pivot arrangement. These steering options are independent and separate from the operation of propelling rams comprising piston and cylinder assemblies 36 and 78, by which the mining machine is advanced. Furthermore, gripper assembly 38, which provides a reaction base for

advancing the cutterhead support assembly 14, is slide mounted on main beam assembly 6. Thus, a fore-aft sliding relationship is established between gripper assembly 38 and the main beam assembly 6. Clearly, the main beam assembly 6 represents the body of the mining machine, and the combination of the cutterhead support assembly 14 and the cutterhead assembly 4 represents a steerable cutterhead of the mining machine.

In contrast, the present invention discloses and claims simultaneous advancing and steering of the mining machine with one set of actuators disposed between a mining machine and an advancing machine independently of the mining machine. (Support for the amendments is seen, for example, at page 8, lines 8-11.) This makes the method of simultaneous advancing and steering simpler, and it also allows adapting and retrofitting the steering and advancing arrangement to any standard mining machine that does not have a steerable cutterhead. There is no sliding arrangement between the grips and the body of the machine. Furthermore, the method of steering and advancing the mining machine is distinctly different from that of Walker since the mining machine is advanced and steered from the rear and the shape of the mining machine is not altered by any steering method or mechanism. Thus, not all of the claimed recitations are seen in the cited reference.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 102 to the claims are believed to be overcome.

#### Claim Rejections Under 35 U.S.C. § 103

On page 5 of the Office Action, the Examiner rejected claim 14 under 35 U.S.C. § 103 in view of Walker modified by Weimer.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or motivation to modify a reference cannot be the Applicant's own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

As discussed above, Walker does not disclose all of the claimed recitations. Weimer does not satisfy the shortcomings of Walker. Thus, not all of the claim recitations are present in the cited references.

In view of the foregoing, the Examiner's rejection under 35 U.S.C. § 103 to claim 14 is believed to be overcome.

#### Additional Fees

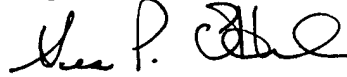
The Commissioner is hereby authorized to charge any insufficiency, including a three-month extension for response fee of \$465, or credit any overpayment associated with this application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 18155.0006).

Conclusion

Claims 1, 10, and 12-14 have been amended, and claims 4-9 and 11 have been canceled. Claims 1-3, 10-20, 23, and 26-44 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Dated: 9/5/03

Respectfully Submitted,



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